


<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number <b>Q80457</b>	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number <b>10/802,868</b>	Filed <b>March 18, 2004</b>	
	First Named Inventor <b>Hiroyuki IIDA</b>		
	Art Unit <b>2627</b>	Examiner <b>William J. Klimowicz</b>	
<p style="text-align: center;">WASHINGTON DC SUGHRUE/265550</p> <p style="text-align: center;"><b>65565</b></p> <p style="text-align: center;">CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number <u>50,214</u></p> <div style="text-align: right;">         Signature     </div> <div style="text-align: right;"> <u>Yan Lan</u>        Typed or printed name     </div> <div style="text-align: right;"> <u>(202) 293-7060</u>        Telephone number     </div> <div style="text-align: right;"> <u>December 30, 2009</u>        Date     </div>			

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q80457

Hiroyuki IIDA

Appln. No.: 10/802,868

Group Art Unit: 2627

Confirmation No.: 5449

Examiner: William J. Klimowicz

Filed: March 18, 2004

For: SLIDING MEMBER

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**MAIL STOP AF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated August 31, 2009, Appellants file this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Claims 1, 2, 4, 6, 7 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 08-031128 to Nagai (JP '128) in view of JP 2002-166401 to Tsubouchi (JP '401).

Claims 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '128 in view of JP '401, and further in view of JP 08-034959 A to Nakanishi (JP '959).

A fundamental issue in the present § 103 rejections is that the Examiner takes the position that the JP '128 discloses a laminate structure having all the features of the present invention with the exception of the position of the barrier layer. The Examiner further takes the position that providing a barrier layer between the porous substrate and adhesive layers to

prevent migration of adhesive into the porous substrate is well known in the art. Moreover, the Examiner asserts that JP '401 expressly discloses that a barrier layer (2) is provided between a porous substrate (1) and an adhesive layer (3) to prevent an adhesive from infiltration into a surface of a porous substrate.

For *at least* the following reasons, Appellants submit that the rejections are in error and should be withdrawn.

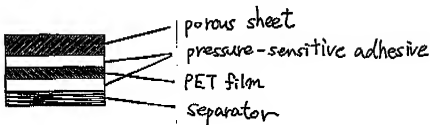
Appellants respectfully disagree with the Examiner's characterization of JP '128. JP '128 does not only fail to disclose the claimed barrier layer, the construction of the member for optical disk protection of JP '128 is clearly different from the claimed sliding member of the present application.

Claim 1 recites a sliding member comprising a slidable substrate; a pressure-sensitive adhesive layer provided on one side thereof; and a barrier layer, wherein the slidable substrate is a porous form having a porosity of 20-70% and comprises an ultrahigh molecular weight polyethylene; and wherein the barrier layer is provided between the slidable substrate and the pressure-sensitive adhesive layer.

In contrast, JP '128 (the primary reference) discloses, for example in Example 1 at paragraphs [0038] to [0039], a double-coated pressure-sensitive adhesive tape that is obtained by applying the pressure-sensitive adhesive to the both sides of the substrate (polyethylene terephthalate film) having a thickness of 25  $\mu\text{m}$ . Then, the separator is attached to one side of the double-coated pressure-sensitive adhesive tape, and the porous sheet is attached to the other

side of the double-coated pressure-sensitive adhesive tape, thereby obtaining the member for optical disk protection.

The resulting member for optical disk protection of JP '128 has the following structure, which is clearly different from that of the present application.



Further, even if JP '401 (the secondary reference) may teach a barrier layer provided between a porous substrate and an adhesive in order to prevent the adhesive (in solution form) from infiltration into the pores, such is not a concern with JP '128.

Specifically, JP '128 teaches that the adhesive is applied to the separator and dried, and then the porous sheet is stuck to the pressure sensitive adhesive. Since the adhesive of JP '128 is dried prior to being attached to the porous sheet, one of ordinary skill in the art would not be concerned with the adhesive infiltrating the pores of the sheet.

Thus, one of ordinary skill in the art would not be motivated to modify JP '128 to provide a barrier layer between the porous substrate and adhesive layers, and much less would one of ordinary skill in the art be motivated to combine the references of JP '128 and JP '401 in the manner suggested by the Examiner.

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For at least the above reasons, Appellants submit that the Examiner has failed to establish a *prima facie* case of obviousness. Thus, claims 1, 2, 4 and 6-11 are patentable over JP '128, either alone or in view of JP '401.

Claims 8-10 depend from claim 1 and would therefore be patentable over the art for at least the reasons mentioned with respect to claim 1.

Accordingly, Appellants respectfully request withdrawal of the final rejections under 35 U.S.C. § 103(a) upon review of the Pre-Appeal Panel.

Respectfully submitted,



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